

REMARKS

Applicants have received and carefully reviewed the Office Action mailed on December 17, 2003. Claims 1-20, 22-88, 90-95, and 97-110 are pending, with claims 21, 89 and 96 cancelled without prejudice, claims 13-17 and 75-79 withdrawn, and claim 110 newly presented herein. Claim 85 has been amended to be an independent claim, and claim 110 is a newly presented dependent claim. Independent claim 96 and dependent claims 21 and 89 have been cancelled, such that no fee is believed necessary for changes to the number of claims. Reconsideration and reexamination are respectfully requested.

Applicants would like to thank the Examiner for the courtesies and information conveyed in a brief telephone interview on January 28, 2004, between the Examiner and Mark Schroeder, Reg. No. 53,566, an associate of the undersigned attorney. An Information Disclosure Statement was filed by Applicants and received at the OIPE on November 14, 2003. The IDS was filed too close to the date of the first Office Action to be considered therein. In the telephone interview, the Examiner acknowledged receipt of the IDS filed by Applicants. In particular, both the Form PTO-1449 as well as the references listed therein have been received by the Examiner. Therefore, Applicants request consideration of the references listed in the IDS before further action. If any individual reference is missing, illegible, or otherwise not in condition for consideration, Applicants request that the Examiner notify Applicants so that the reference may be re-submitted in time for consideration before issuance of a Notice of Allowance or other Final Action.

Applicants have amended each of the independent claims, as well as several dependent claims, to replace the phrase "single incision" with the word "incision." These amendments are intended to clarify the claim scope. In particular, while a single incision may be used to perform the several method steps recited, additional incisions may be made for further therapeutic or diagnostic purposes in addition to the recited incision. Therefore, the claims have been amended to avoid any confusion as to whether the phrase "single incision" was limiting.

In paragraphs 1 and 2 of the Office Action, the Examiner noted the earlier election of species in which claims 13-17 and 75-79 were withdrawn from consideration. It is believed that generic claims reading over these species, in particular claims 1 and 63, are now in condition for

allowance. Withdrawal of the restriction and consideration of these claims is respectfully requested.

In paragraph 3 of the Office Action, the drawings were objected to. Attached hereto are copies of formal drawings for inclusion in the present application. The formal drawings include, as noted, reference numeral 228 in both Figures 23A and 23B. The change is reflected in the attached redline figure. It is believed that this objection is overcome with the filing of the formal drawings.

In paragraph 4 of the Office Action, claims 25, 47 and 89 were objected to for including a misspelling of "inframammary." Claim 47 does not contain the misspelling and is believed to be included in the objection merely as a typographical mistake. Claims 25 and 89 have both been amended to change the spelling of "inframmary" to "inframammary". It is believed that these objections are overcome with the above amendments.

In paragraph 5 of the Office Action, claim 101 was objected to for lacking a verb. Claim 101 has been amended in accordance with the Examiner's suggested "electrode is disposed" phrase. The objection is therefore believed to be overcome.

In paragraph 7 of the Office Action, claims 10, 12, 30-63, and 82 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite as a result of their dependency from other objected-to claims. It is believed that the above amendments have remedied and overcome these rejections.

Also in paragraph 7, claim 2 was objected to for the limitation "the canister." Applicants note that claim 2, as originally presented, did not depend upon another claim due to an error. Applicants have amended claim 2 to correctly depend from claim 1, as suggested by the Examiner. This amendment is believed to overcome the above rejection.

Claims 10, 12, 30, 31, 61, and 62 were objected to based upon certain terms lacking antecedent basis. These claims, along with claims 94 and 95 (which contained similar language to that of claims 61 and 62), have been amended as suggested, replacing the phrases "the width" and "the length" with "a width" and "a length", where appropriate. These amendments are believed to overcome their corresponding rejections.

Claim 32 was objected to on the basis of a phrase. The Examiner suggested that Applicants rephrase a portion of claim 32 to recite "advancing the ICD through the single

incision and subcutaneously in the area defined between approximately a patient's third rib and approximately a patient's twelfth rib." Except for removal of the word "single", Applicants have followed the Examiner's suggestion in the above amendments. Therefore, claim 32 is believed to be in condition for allowance.

Claim 82 was objected to for reciting "the electrical circuit" in line 2, the Examiner stating that this term lacked antecedent basis. However, Applicants note that claim 82 depends from claim 81, which depends from claim 71, which depends from claim 63, which recites "an electrical circuit located within the housing." Thus it is believed that antecedent basis for "the electrical circuit" already exists in the base claim for claim 82, and the objection should be withdrawn.

In paragraph 9, claims 1-12, 18-20, 24, 28-31, 63-74, 80-81, 84, 88, 90, and 92-109 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,292,338 to Bardy in view of U.S. Patent No. 5,645,586 to Meltzer and further in view of U.S. Patent No. 5,895,414 to Sanchez-Zambrano.

In paragraph 10 of the Office Action, claims 23 and 87 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bardy in view of Meltzer and Sanchez-Zambrano.

In paragraph 11 of the Office Action, claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over Bardy in view of Meltzer and Sanchez-Zambrano.

In paragraph 12 of the Office Action, claims 82-83 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bardy in view of Meltzer and Sanchez-Zambrano, and further in view of U.S. Patent No. 5,713,926 to Hauser et al.

In paragraph 14 of the Office Action, claims 21-22, 27, 85, 86, 89 and 91 were objected to as being dependent upon rejected base claims. It appears from the comments following paragraph 14 that the Examiner also found claim 25 to include patentable subject matter. In order to expediate prosecution of this matter, Applicants have chosen to amend the claims rather than argue against the above objections and rejections.

In particular, claim 1 has been amended to incorporate allowable claim 21. It is believed that this amendment overcomes the rejections and objections to claims 2-12, 18-20, and 22-31, as claim 1 is now believed to be in condition for allowance.

Also, claim 63 has been amended to incorporate allowable claim 89. It is believed that this amendment overcomes the rejections and objections to claims 64-74, 80-85, 87, 88, and 90-95.

Claim 86 has been amended to incorporate claim 63 to become an independent claim, and is therefore believed to be in condition for allowance. Claim 97 has been amended to depend on claim 86, such that claims 97-109 are now believed to be in condition for allowance.

Claims 21, 89 and 96 have been cancelled without prejudice, such that objections and rejections of these claims are moot.

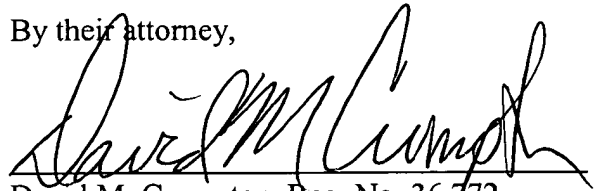
Newly presented claim 110 depends from claim 1, further reciting that the incision is made approximately in the left anterior axillary line, and the cardioverter-defibrillator is advanced medially toward approximately a patient's left inframammary crease between the patient's third and the patient's twelfth rib. Claim 110 combines the recitations of claims 22, 25 and 27, and depends from amended claim 1 which has added the recitation of previous claim 21. As such, claim 110 combines each of several claims that have been noted by the Examiner as containing patentable subject matter that are dependent from claim 1. Therefore, claim 110 is believed to be in condition for allowance.

Reconsideration and reexamination are respectfully requested. It is believed that all pending claims, namely claims 1-20, 22-88, 90-95, and 97-110, are in condition for allowance. Issuance of a notice of allowance in due course is respectfully requested. If there are any questions, or if a telephone interview might be of assistance, please contact the undersigned attorney at 612-677-9050.

Respectfully submitted,

Gust H. Bardy et al.

By their attorney,



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Attachment (15 sheets of formal drawings)